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| WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251 | | | GARG, YOGESH C | |
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| | | | 3625 | |

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/718,283 | Applicant(s) CARDENAS, FRANK A. | |
| | Examiner Yogesh C Garg | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/21/05 & 1/3/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/21/2005 has been entered.

Response to Amendment

2. Applicant's amendment received on 1/3/2005 is acknowledged and entered. The applicant has amended claims 1, 11, and 17. Currently claims 1-19 are pending for examination.

Response to Arguments

31. Since the Applicant has amended the claims 1 and 17, the rejection of claims 1-19 under 35 USC 112, second paragraph is withdrawn.

3.2. Applicant's arguments with respect to rejection of claims 1-19 under 35 USC 103 (a) have been considered but are not persuasive for following reasons:

The applicant argues (see Remarks, page 10, line 21-page 11, line 13 that, " Roach fails to disclose or anticipate a plurality of computers coupled to different on-line retailers where individuals can order merchandisecan return the on-line store shopping card for cash on unused credit after shipping at the store". The examiner combined references Hoang, Roach, Cohen and Weiss to show that the limitations are obvious but the applicant is attacking individual reference of Roach. In response to applicant's arguments against the references

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individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Roach reference teaches that individuals can order merchandise via a plurality of computers housed in a store and have the merchandise delivered to the store for pick-up (see at least col.3, line 51-col.4, line 21) as analyzed in the previous office action. As regards the limitations of using an online shopping prepaid card and for being able to return the shopping card for cash on unused credit after shopping at the store, the examiner combined the teachings from Cohen and Weiss references respectively. Similarly, the applicant attacks (see Remarks, page 11, lines 14-21) the Cohen reference individually because examiner combined the teachings of Weiss for the limitation of being able to return the shopping card for cash on unused credit after shopping at the store.

The applicant argues (see Remarks, pages 11-14) that the examiner has not established a prima facie case of obviousness because references Hoang, Roach and Weiss cannot be combined as they belong to different classes and that the teachings from the prior art itself or knowledge generally available to one of an ordinary skill in the art appear to suggest the claimed subject matter to a person of an ordinary skill in the art. The examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all the limitations as claimed are taught by the combined references, and

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either the references, individually or combined, or one of an ordinary skill in the art suggest obviousness of the claimed limitations, see pages 4-9 of the previous office action. In the previous office action the examiner has provided, see pages 5-6 for reference Roach, pages 7-8 for reference Cohen and pages 8-9 for reference Weiss in the previous office action as how and why the prior art or one of an ordinary skill in the art would be able to conclude obviousness of the claimed limitations. Incidentally, the applicant has not argued against these submissions provided by the examiner.

Further on response to applicant's argument that references Hoang, Roach and Weiss cannot be combined as they belong to different classes, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the examiner has shown that the prior art references of Roach, Cohen and Weiss were reasonably pertinent to the particular problems with which the applicant was concerned, see pages 4-9 of the previous office action, and therefore combination of the teachings of the said references constitute analogous art.

In view of the above, the rejections of claims 1-19 are sustainable.

4. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially

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teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claims 1-7, 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang in view of Roach et al. (US Patent 5,434,394), hereinafter, referred to as Roach, in view of Cohen in view of Weiss (US Patent 6,511,377 B1) and further in view of Greenstone (US Publication 2001/0047303 A1).

Regarding claim 1, Hoang in view of Cohen teaches a system for secure and Private on-line shopping comprising, in combination:

Hoang discloses:

an on-line shopping store server coupled to the plurality of computers of the on-line shopping store for hosting an on-line shopping store web site (see at least col. 4, line 62-col.5, line 29, *".....FIG. 1 is a simplified block diagram of a client-server network 100 for referencing remote merchant sites at a local commerce site according to an embodiment of the present invention. The local commerce site may also be a remote merchant integration server (RMIS). Client server network 100 has a user client 110, a network A 120, a remote merchant integration server (RMIS) 130, a network B 140, and remote merchant sites 152, 154, 156. The client server network 100 can be any suitable network such as a wide area network or local area network such as an intranetIn an embodiment of*

the present invention, user client 110 sends a client request (client request 1, client request 2, client request N) to RMIS 130 via network A 120. RMIS 130 is also called the local commerce site. RMIS 130 processes the client request (client request 1, client request 2, client request N) and sends a processed client request to a remote merchant site (remote merchant site 1, remote merchant site 2, remote merchant site N) via network B 140. " Note: The local remote commerce site/RMIS corresponds to the online shopping store/store web site coupled to a plurality of computers , that is client requests 1, 2....N and to a plurality of on-line retailers, that is merchant site 1, 2,...N). Hoang further discloses purchasing products and services on Internet (see col.2, lines 5-8). It will be inherent to make payments when you make purchases.

Hoang as applied to claim 1 above does not disclose that the plurality of computers are housed in a store where individuals can order merchandise and have the merchandise delivered to the store for pick-up. However, in the field of automated order and delivery system in a store, Roach teaches that individuals can order merchandise via a plurality of computers housed in a store and have the merchandise delivered to the store for pick-up (see at least col.3, line 51-col.4, line 21, " *A further enhancement to the purchasing process is realized with the use of hand-held, pen-based sale transaction computers. The customer selections are entered into the sale transaction record, Once the merchandise is selected at the point of decision, the point of sale system sends information to the warehouse facility to enable the merchandise to be picked from the warehouse and sent to the delivery location,* " . Also see Fig.1 and col.3, line 25-col.4, line 6. Computers , " 18, 18A, 18B" represent the plurality of computers which are coupled to an online server "20". Note: Hoang already teaches that the server hosts shopping web site (see Hoang, " RMIS 130").

In view of Roach, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention, to have modified Hoang to incorporate the feature of enabling consumers order merchandise via a plurality of computers housed in a store and have

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the merchandise delivered to the store for pick-up. By doing so it helps to deliver merchandise to customers for pick up in the shortest possible time and minimize the use of labor, as explicitly suggested in Roach (see at least col.2, lines 56-68).

Hoang in view of Roach as applied to claim 1 above does not disclose an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a prepaid card having an assigned monetary value and a shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line store shopping card, for crediting and debiting the monetary value of the on-line store shopping card, and for transferring payments to and from a user of the on-line store shopping card and the on-line retailers.

However, in the same field of endeavor, Cohen discloses an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a prepaid card having an assigned monetary value and a shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line store shopping card, for crediting and debiting the monetary value of the on-line store shopping card, and for transferring payments to and from a user of the on-line store shopping card and the on-line retailers (see at least col.4, lines 16-48, "*Referring now to FIG. 1, a transaction system, generally designated 30, for handling purchasing transactions between a first party 31, typically a consumer, and a second party 33, typically a merchant, over a global computer network 32 such as the Internet is provided in accordance with a preferred embodiment of the present invention. The purchasing transactions are processed by a third party administrator 35. A plurality of pre-paid cards 34, which are generated by the third party administrator 35 and maintained at a distribution site 36, facilitate the purchasing transaction by providing a medium of exchange between the three parties. A pre-paid card purchasing option 50 is provided within such display site 40. Selection of the purchasing option 50 transfers the consumer 31 to the administrative computer 52 which generates a*

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preformatted display page 102 (FIG. 8) substantially duplicating the merchant's display and handles the fund verification portion of the transaction. An administrative repository 62 and a merchant repository 64 further handle the transfer of funds between the parties. ". Note: The pre-paid card corresponds to the on-line store shopping card, the third party administrator 35 and the administrative computer 52 corresponds to a shopping on-line card server coupled to the on-line store server already disclosed by Hoang and analyzed above. This administrative computer verifies the authenticity and implements the crediting and debiting the monetary value of the on-line pre-paid shopping card and for transferring payments to the merchants/on-line retailers as claimed in the application).

In view of Cohen, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Hoang in view of Roach as applied to claim 1 above to incorporate the features of an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a prepaid card having an assigned monetary value and a shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line store shopping card, for crediting and debiting the monetary value of the on-line store shopping card, and for transferring payments to and from a user of the on-line store shopping card and the on-line retailers. Doing so would help : (1) to process the payment and close the transaction by using pre-paid debit cards, which would help in preventing credit card fraud, avoiding excessive debt, and (ii) further helping the retailer web sites by relieving them from the burden of verification/authentication process, processing payment, and fulfillment of the orders and therefore freeing the valuable resources of the retailer web site to focus on displaying and marketing their products/services.

Hoang/Roach/Cohen combined, as applied to claim 1 above, does not teach that individuals are able to return the on-line store card for cash on unused credit after shopping at the store. However, in the analogous field of cashless gaming system, Weiss teaches that

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individuals are able to return the on-line store card for cash on unused credit after shopping at the store (see at least, , col.4, line 53- col.5, line 58, " *.....Another further object of the present invention as characterized above which provides a player with the opportunity of opening an electronic account at an enrollment station and depositing funds into their account using cash, chips, a check or a marker.* Another further object of the present invention is to provide a system as characterized above which includes providing secure playing cards to each individual who has opened an electronic account.Another further object of the present invention is to provide a system as characterized above which includes a redemption apparatus in which players may access their available account balances with their player cards and redeem these balances for cash and perquisite vouchers directly from the redemption apparatus. ". Note: In Weiss, the player cards correspond to pre-paid on-line store cards in which the balances, that is the unused credit can be returned for cash after playing (corresponds to shopping in the claimed application. In the claimed application the user consumes the credit in the pre-paid store card for shopping and in Weiss the user consumes the credit in the pre-paid player card for playing. Also see col.1, lines 5-16, col.3, line 55-col.4, line 45, col.7, lines 47-58, and col.19, line 60-col.20, line 41).

In view of Weiss, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Hoang/Roach/Cohen, as applied to claim 1 above, to incorporate the feature of enabling consumers to return the on-line store card for cash on unused credit after shopping/playing at the store. By doing so the customers would have the flexibility to consume the credit balance of the card as per his or her requirement/liking and would not be forced to use the entire amount of the card against his wishes and further enable them to redeem the balance amount left in the card, as explicitly suggested in Weiss.

Hoang/Roach/Cohen/Weiss does not suggest entering a delivery location if delivery is not to the store. However, Greenstone teaches entering a delivery location if delivery is not to the store (see at least paragraphs 0007-0011 on page 1 which discloses that the invention

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allows a buyer to locate quickly and easily a source from where he can receive the desired products, that is tires, and that allows him not to be tied with any one store, like the store from where he is ordering). In view of Greenstone, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Hoang/Roach/Cohen/Weiss, as applied to claim 1 above, to incorporate the feature of enabling consumers entering a delivery location if delivery is not to the store because it allows customers to have the flexibility to buy any products from anywhere, as per his convenience, and not being confined or limited to products only available in the store, as explicitly suggested in Greenstone.

Regarding claim 2, Hoang/Roach/Cohen/Weiss/Greenstone combined as applied to claim 1 discloses at least one home computer coupled to the on-line shopping store server for accessing on-line retailers (see at least Hoang, FIG.1, user client computer corresponds to a home computer. The user client can be anywhere depending upon the user's location that is at home, office, etc.).

Regarding claim 3, Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 2 teaches a system for secure and private on-line shopping . Cohen further teaches comprising an outside server coupled to the on-line shopping store server and the on-line shopping card server for accessing web sites that not located on the on-line shopping store server (see at least col.7, lines 43-52, *"The third host is an administrative server 52 that communicates with the consumer host 39 and merchant host 41. Such administrative server maintain an activation web site 42, generate and store preformatted displays 102, communicate with other network servers and a fund repository 62, verify the viability of a purchasing transaction, and maintain at least one transactional database 46 capable of storing a plurality of user records 44 "*. Note: communicating

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with other network servers correspond to accessing web sites that not located on the on-line shopping store server). In view of Cohen, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Hoang/Roach/Cohen/Weiss as applied to claim 2 to incorporate the feature of accessing web sites that not located on the on-line shopping store server. Doing so would help : (1) to access bank servers/server of the issuer of the pre-paid cards to check the authenticity and (ii) further helping in connecting to other merchant sites to do comparison shopping as suggested in Cohen (see col.2, lines 5-8).

Regarding claim 4, Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 1 discloses that on-line retailers are formed into a single network of sites and are hosted on the on-line shopping store server (see at least FIG.1 and Hoang, col. 5, lines 12-22, “ RMIS 130 processes the client request (client request 1, client request 2, client request N) and sends a processed client request (processed client request 1, processed client request 2, processed client request N) to a remote merchant site (remote merchant site 1, remote merchant site 2, remote merchant site N) via network B 140. “. Note: The merchant sites 1, 2...n represented by 152, 154,...156 correspond to the claimed on-line retailers formed into a single network via “140” and hosted on the on-line shopping store server web site, that RMIS 130).

Regarding claim 5, Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 1 discloses that the on-line shopping server host a home web page having hyperlinks to the on-line retailers (see at least col.1, lines 1-48, “ The present invention relates generally to a distributed network of hyperlinked document.....”).

Regarding claims 6 , 7, & 9, Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 1 discloses that the on-line shopping card has an identification number which is used

when purchasing goods from the on-line retailers and the identification number is located on the on-line shopping card or on a piece of paper attached to the on-line shopping card (see at least Cohen, FIG.3 which represents the shopping pre-paid card displays an identification number located on the card, col.4, line 49-col.5, line 3). In view of Cohen, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Hoang/Roach/Cohen/Weiss as applied to claim 1 to incorporate the feature that the on-line shopping card has an identification number which is used when purchasing goods from the on-line retailers and the identification number is located on the on-line shopping card. Doing so would help : (1) to identify the pre-paid card and correlate it for verification/authentication so that payment can be transferred from the card to the merchant, and (ii) further helping the consumers to read the identification number from the card /or from a piece of paper like a printed receipt, as it is widely practiced when using the credit-cards.

Regarding claim 10, Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 1 also discloses that the on-line shopping card is a programmable on-line shopping card (see at least Cohen col.5, lines 30-36, “ *expensive technology associated with so-called smart cards which typically include a chip or magnetic strip embedded into the card surface.....*”). Note: The smart cards correspond to programmable on-line shopping cards. Here, Cohen discloses the use of smart cards, as an admitted prior art explicitly disclosing that information from these cards can be read by using a card reader and that information can include information about the user). In view of Cohen, it would have been obvious to a person of an ordinary skill in the art to have modified Hoang/Roach/Cohen/Weiss as applied to claim1 to incorporate the feature of smart card because by doing so it allows an alternative to use IC-cards for receiving relevant information

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stored in the cards and also to store/transmit information to these smart cards, like adding monetary value, etc.

Regarding method claims 11-16, their limitations correspond to the functional limitations of the system claims 1-6 and are therefore analyzed and rejected as being unpatentable over Hoang/Roach/Cohen/Weiss/Greenstone on the basis of same rationale.

5.2. Claim 8 is are rejected under 35 U.S.C. 103(a) as being obvious over Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 7 in view of an Official Notice.

Regarding claim 8, Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 7 discloses that the on-line shopping card has an identification number which is used when purchasing goods from the on-line retailers and the identification number is located on the on-line shopping card or on a piece of paper attached to the on-line shopping card. Hoang/Roach/Cohen/Weiss as applied to claim 7 does not disclose that the identification number located on the on-line shopping card is covered with a removable opaque adhesive tape. The examiner takes an Official Notice of the well-known concept and benefits of covering the identification number located on the on-line shopping card is covered with a removable opaque adhesive tape for the obvious reason of not displaying it to the unauthorized people and in case if it has removed then it will indicate that the card has been tampered by unauthorized people and thereby caution the user to alert the concerned authorities.

5.3. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang in view of Roach in view of Cohen and further in view of Weiss.

Regarding claim 17, Hoang/Roach/Cohen/Weiss/Greenstone as applied to claims 1 & 6 already covers the following limitations:

A method for making secure and private on-line purchases comprising the steps of:

Providing a store housing a plurality of computers, the store functioning as an on-line shopping store where individuals can order merchandise and have the merchandise delivered to the store for pick up;

providing an on-line shopping store server coupled to the plurality of computers of the on-line shopping store for hosting an on-line shopping store web site;

purchasing an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a pre-paid card having an assigned monetary value and identification number;

entering the identification number of the on-line store shopping card;

verification of the identification number and funds remaining on the on-line store shopping card;

entering a delivery location of the goods and items purchased if delivery is not to the store when the identification number and funds are verified.

Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 17 above does not disclose selecting goods and items to purchase. However, Cohen teaches this limitation (see Cohen at least col.6, line 61-col.7, line 16) for the obvious reason of permitting the customer to have his choice in purchasing the goods. In view of Cohen, it would have been obvious to one of an ordinary skill in the art at the time of the invention to have modified

Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 17 to incorporate the feature of letting users select goods and items to purchase because it enables them to choose and reject items from a displayed list of items for purchase.

Regarding claim 18, Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 17 does not disclose the step of assigning a Personal Identification Number (PIN) to the on-line store shopping card. However, Cohen teaches this limitation (see Cohen at least col.8, lines 4-13, "*password 81*" corresponds to PIN.). In view of Cohen, it would have been obvious to one of an ordinary skill in the art at the time of the invention to have modified Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 17 to incorporate the step of assigning a Personal Identification Number (PIN) to the on-line store shopping card because it allows to authenticate the real user and to avoid fraudulent use of the shopping card.

5.4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoang/Roach/Cohen/Weiss/Greenstone and further in view of Yamada.

Regarding claim 19, Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 17 teaches a method for making secure and private on-line purchases and entering a delivery location of the goods and items purchased. Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 17 also discloses selecting the on-line shopping store as the delivery location (Note: the delivery location is already specified in the limitations of claim 17 above by specifying that the goods are to be delivered at the store from where they are ordering the merchandise. See also the rejection of this claim under 35 U.S.C. 112, second paragraph, above)

Hoang/Cohen as applied to claim 17 does not disclose:

calling a purchaser when the goods and items purchased have arrived at the on-line shopping store.

However, Yamada, in the same field of endeavor, teaches calling a purchaser when the goods and items purchased have arrived at the on-line shopping store (see at least col.3, lines

43-48, "*The server 1 then transmits the date information to the terminal equipment 3a of the customer...*". Note: informing the customer about the delivery of items at the designated delivery station corresponds to the claimed limitation. The process of informing could be a choice such as informing by telephone, or mail or e-mail, etc. and such design choices are well –known and are subjective in nature which does not warrant a patentable distinctness over the prior art of Yamada.). In view of Yamada, it would have been obvious to a person of an ordinary skill in the art to have modified Hoang/Roach/Cohen/Weiss/Greenstone as applied to claim 17 to incorporate the feature of calling a purchaser when the goods and items purchased have arrived at the on-line shopping store because by doing so it will enable the customer to plan the pick up of the delivered item as per his convenience.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Publication 2002/0019781 to Shooks et al. discloses ordering products on a shopping web site from a plurality of computers housed in a brick and mortar on-line shopping store using an Internet card (see at least paragraph 0053).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
April 18, 2005